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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,853	08/13/2001	Martin Melchiors	Mo-6476/LcA 34,678	8274
157	7590	12/13/2005	EXAMINER	
BAYER MATERIAL SCIENCE LLC			SERGENT, RABON A	
100 BAYER ROAD			ART UNIT	
PITTSBURGH, PA 15205			PAPER NUMBER	

1711

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/928,853

Applicant(s)

MELCHIORIS ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 15, 2005 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al. ('393) in view of EP 159117.

Blum et al. disclose water dispersible binder compositions comprising a urethane modified polyester polyol, derived from reactants that overlap those of applicants, and a blocked polyisocyanate component. See abstract and columns 3-6.

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4. Though Blum et al. disclose numerous blocking agents for masking the polyisocyanate, patentees are silent regarding the use of pyrazole blocking agents. Still, the use of pyrazoles as blocking agents for polyisocyanates that are to be incorporated into aqueous compositions in masked form was known at the time of invention. This position is supported by the teachings of EP 159117 at page 4, lines 4+. Additionally, the secondary reference discloses that a benefit of using the pyrazole blocking agents is that the deblocking temperature is significantly lower as compared to the deblocking temperature of other conventional blocking agents. Since lower deblocking temperatures require less energy input and, therefore, require less expense, the position is taken that it would have been obvious to utilize the pyrazole blocking agents within the primary reference, so as to obtain a coating system that is less expensive to apply.

5. Applicants' argument that the instant claims differ from the prior art because the prior art requires that the urethane modified polyester be aqueously dispersed prior to addition of the blocked isocyanate (crosslinking agent) is not well taken for the following reasons. Firstly, applicants' argument and declarations are not adequately representative of the prior art, because the position is maintained that the prior art does not require that the crosslinking agent be added after formation of the dispersion. Though Blum et al. disclose embodiments where the urethane modified polyester is dispersed before the blocked polyisocyanate is added, Blum et al. further disclose at column 7, lines 16-19 that the binder compositions may be prepared simply by mixing components a), b), and c); given the description of these components within the reference, it appears clear that water is not a required component of any of components a), b), or c). Furthermore, applicants' attention is directed to the aforementioned text at column 7, lines 16-19. The text reads, "The binder compositions according to the invention or aqueous dispersions

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prepared therefrom may be prepared simply by mixing the individual components a), b) and c)."

The language, "or aqueous dispersions prepared therefrom", clearly indicates that the language, "the binder compositions", refers to undispersed compositions that comprise components a), b) and c). No other interpretation of the language is reasonable. Therefore, despite applicants' response, it cannot be said that Blum et al. require that the crosslinker be added after formation of the aqueous dispersion, and for this reason, it is not seen that applicants' claims are distinguished from the prior art in the manner argued by applicants. Secondly, applicants' argument that the aforementioned text has been taken out of context is not well-taken. In fact, it is not seen how the text could be taken out of context, because it is seemingly quite clear on its face. The argued text simply discloses an alternative embodiment of the disclosed invention. It has been held that a reference is good for all that it teaches, and the position is taken that this premise applies to alternative embodiments. Given the situation at hand, it is not seen that applicants' relied upon court decision has been properly applied. In summation, applicants have not set forth a convincing argument why this teaching should be dismissed.

6. Lastly, the 37 CFR 1.132 declarations of July 1, 2004 and November 15, 2005 have been considered; however, the declarations are insufficient to overcome the prior art rejection. Firstly, despite applicants' arguments, given the breadth of applicants' claims, it is not seen that the examples of the declarations exemplifying applicants' invention are commensurate in scope with the claims. Secondly, applicants' only example of a process wherein the blocked isocyanate is added to the aqueous dispersion appears in the declaration of July 1, 2004, and the position is taken that this example is not representative of the relied-upon prior art, namely Blum et al. Neither the polyester nor the diisocyanate of the example correspond to the teachings of the

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reference; therefore, it is unclear that any meaningful comparison can be made between the example and the prior art. Furthermore, the secondary reference clearly discloses that the claimed blocking agent are used in the production of aqueous isocyanate-based coating compositions (see page 4, line 4 of EP 159,117); therefore, this serves as further evidence that the skilled artisan knew how to utilize the claimed blocking agent in an aqueous system at the time of invention. It is not seen that applicants' arguments and declarations have addressed this fact.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sergent  
December 6, 2005